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REMARKS

Double Patenting

All claims in the present application are rejected in the Office Action dated September 24, 2004 for obviousness-type double patenting over claims 1-12 of copending Application No. 09/881915, over claims 10-15 of copending Application No. 09/881919, over claims 1-20 of copending Application No. 09/881917, and over claims 1-12 of copending Application No. 09/882173.

The Office Action states that claims 1-66 are rejected as being unpatentable over claims 1-12 of copending Application No. 09/881915 because:

... they are not patentably distinct from each other because the limitations of the independent claims 1, 23, 45 are similar to claim 1 of copending Application No. 09/881915. The limitations 'implementation using a transcoding gateway containing digital content' is equivalent to the use of digital content information by transcoding gateway to stream digital content. The use of e-mail containing fields of information (i.e., email mechanism) is well known in the art (for example, Microsoft outlook, specification, paragraph 6).

The law governing double patenting is that the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) are applied for establishing a background for determining obviousness under 35 U.S.C. 103 and are employed when making an obviousness-type double patenting rejection. The *Graham* factual inquiries require the Examiner to:

- determine the scope and content of the art as described in copending application no. No. 09/881915;

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- determine the differences between the scope and content of the art as described in copending application no. No. 09/881915 and the claims at issue;
- determine the level of ordinary skill in the pertinent art; and
- evaluate any objective indicia of nonobviousness.

The Office Action Fails to Establish the Required
Background for the Double Patenting Rejection

As described above, the Office Action must apply the Graham factors to establish the required background for a double patenting rejection. The Office Action fails to apply a single Graham factor to establish any of the necessary background elements for determining obviousness. In fact, the Office Action does not even mention the *Graham* factors. In the complete absence of any mention or consideration of the Graham factors whatsoever, applicants can offer no further analysis on this issue. The Office Action clearly cannot support an obviousness-type double patenting rejection, and the rejection should be withdrawn.

The Office Action Fails to State Reasons Why a Person of Skill
in the Art Would Conclude that the Claims are Obvious

The Office Action presents no argument why a person of ordinary skill in the art would conclude that claims 1-66 in the present case are obvious in view of claims 1-12 of copending Application No. 09/881915. Regarding the art, the Office Action says:

The use of e-mail containing fields of information (i.e., email mechanism) is well known in the art (for example, Microsoft outlook, specification, paragraph 6).

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The reference to "specification, paragraph 6" is a reference to paragraph 6 of the present application as published, publication number US-2002-0194366-A1. What paragraph 6 of publication number US-2002-0194366-A1 actually states is:

Email messages are delivered to email clients, software application programs capable of connecting to the Internet through mail servers and downloading email messages from electronic mailboxes maintained in email servers. An examples of email clients are Microsoft's well-known email applications called OutlookTM and Outlook ExpressTM.

Clearly paragraph 6 says not one word regarding why a person of ordinary skill in the art would conclude that claims 1-66 in the present case are obvious in view of claims 1-12 of copending Application No. 09/881915. The Office Action therefore cannot support an obviousness-type double patenting rejection and the rejection should be withdrawn.

Summary Regarding Double Patenting

The double patenting rejections of the claims of the present application over claims 10-15 of copending Application No. 09/881919, over claims 1-20 of copending Application No. 09/881917, and over claims 1-12 of copending Application No. 09/882173 should be withdrawn for the same reasons as set forth above for the rejections over claims 1-12 of copending Application No. 09/881915. In summary regarding the double patenting rejections, therefore: The Office Action of September 24, 2004, does not establish the necessary background for determining obviousness required by an obviousness-type double patenting rejection. Furthermore, the Office Action fails to articulate reasons why a person of ordinary skill in the art would conclude that claims 1-66 in the present case are obvious in view of claims 1-12 of copending Application No. 09/881915, claims 10-15 of copending Application No. 09/881919, and claims 1-20 of copending Application No. 09/881917. The rejection of claims 1-66 should therefore be withdrawn.

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Title of The Application

There is no need to amend the title of the present application. The Office Action states:

The present title is not sufficient for proper classification of the claimed subject matter.

Applicants in response respectfully note that 37 C.F.R. § 1.72(a) requires titles to be “as short and specific as possible.” The title of the present application is “Email Routing According to Email Content.” Applicants propose that the title is short, specific, descriptive, and in complete compliance with 37 CFR § 1.72(a). Applicants therefore respectfully decline to amend the title.

Brief Summary of the Invention

There is no need to amend the Summary. The Office Action states:

The ‘Brief Summary of the Invention’ should contain brief description of the disclosed subject matter rather repetitive claimed language of the claims.

Applicants respectfully note that 37 C.F.R. §1.73 requires, “Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.” Applicants use claim terminology to assure compliance with 37 C.F.R. § 1.73. Applicants respectfully propose that claim terminology is the very best terminology for compliance with 37 C.F.R. 1.73 because claim terminology is assured to be “commensurate with the invention as claimed.” For these reasons, applicants respectfully decline to amend the Brief Summary of Invention.

Requirement of Information

There is no need to provide additional information. The Office Action states:

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Unless the invention is created from scratch, applicants needs to provide all the prior arts that have led to the invention, i.e., existing patents and publications related to the claimed subject matter. In response, applicants is requested to provide the title, citation and copy of each publication related to the claimed subject matter. For each publication, please provide a concise explanation of that publication's contribution to the description of the prior art. Appropriate correction is required.

37 CFR 1.105(a)(3) provides, "Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply." Applicants respectfully submit, in accordance with 37 CFR 1.105(a)(3), that the information required is unknown and is not readily available to the applicants.

Claim Rejections – 35 U.S.C. § 103

Claims 1-66 are in the case. Applicants have amended claims 17, 18, and 46-66 to repair minor typographical errors in the claims. Independent claims 1, 23, and 45 stand rejected under 35 U.S.C § 103(a) as unpatentable over a reference entitled Application Server Solution Guide, Enterprise Edition: Getting Started, Nusbaum, et al., May 2000, pages 1-45, 416-434 (hereafter 'Nusbaum'); in view of Java Media Framework API Guide, JMP 2.0 FCS, November 19, 1999, Sun Microsystems, page 1-66, 109-135, 173-178 (hereafter 'Sun1'); in further view of JavaMail API Design Specification, Version 1.1, Sun Microsystems, August 1998, pages 1-21, 41-50, 55-60 (hereafter 'Sun2'). As explained in detail below, applicants respectfully traverse the rejections of the present claims under 35 USC § 103(a).

To establish a prima facie case of obviousness, three elements must be proven by the Examiner. MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to modify or to combine

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Nusbaum, Sun1 and Sun2. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed modification or the proposed combination of Nusbaum, Sun1 and Sun2. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed modification or the proposed combination of Nusbaum, Sun1 and Sun2 must teach or suggest all of applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, neither the modification nor the combination of Nusbaum, Sun1, and Sun2 establishes a prima facie case of obviousness. The rejection of claims 1-10, 13, 15-18, 23-32, 35, 37-40, 45-54, 57, 59-62 should therefore be withdrawn and the case should be allowed.

The Cited References Set Forth No Suggestion to
Modify or Combine Nusbaum, Sun1, and Sun2

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify or combine Nusbaum, Sun1, and Sun2. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner has not pointed to any disclosure in Nusbaum, Sun1, or Sun2 suggesting the desirability of the combination. Moreover, there is no possibility whatsoever that the Examiner could ever point to any disclosure in Nusbaum, Sun1, or Sun2 suggesting the desirability of the combination. Nusbaum in fact makes no mention whatsoever of transcoding, makes no pertinent mention of email, and therefore could not possibly suggest the desirability of the combination. In addition, no such suggestion occurs in either Sun1 or Sun2. Absent such a showing of desirability, the Examiner has impermissibly used "hindsight" occasioned by applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d

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982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The proposed combination of Nusbaum, Sun1, and Sun2 therefore cannot possibly establish a prima facie case of obviousness. The objection should be withdrawn, and the case should be allowed.

There is No Reasonable Expectation Of Success in the
Proposed Combination of Nusbaum, Sun1, and Sun2

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Nusbaum, Sun1 and Sun2. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The Examiner has not pointed to any disclosure in Nusbaum, Sun1, and Sun2 suggesting any expectation of success. Absent such a showing of an expectation of success, the Examiner has failed to meet one of the three basic elements of a prima facie case of obviousness.

There can be no reasonable expectation of success in a proposed combination if the proposed combination changes the principles of operation of Nusbaum, Sun1, and Sun2. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The Office Action states:

As per claims 1, 23, 45, Nusbaum teaches a method, system and a software product to implement an email administration in a transcoding gateway (e.g., use of application server, title), the transcoding gateway comprising client device records stored in computer memory (e.g., Java Server pages containing client information, section 1.4, page 13, each client device record representing a client device, (e.g., Java Server pages containing client information, section 1.4, page 13) ...

What Nusbaum actually states in section 1.4, page 13 is:

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JavaServer Pages (JSP) technology provides developers with an easy and powerful way to build Web pages with dynamic content. JSPs dynamically generate HTML, eXtensible Markup Language (XML), ...

That is, Nusbaum teaches a kind of dynamic web page technology known as Java Server Pages or 'JSP.' As stated in Nusbaum, "JavaServer Pages (JSP) technology provides developers with an easy and powerful way to build Web pages with dynamic content." Nusbaum, section 1.4, page 13.

Sun1 and Sun2 taken together teach some kind of transcoding and some kind of email:

"Transcoding is the process of converting each track of media data from one input to another." Sun1, page 33.

"Application developers who need to 'mail-enable' their applications." Sun2, page 1.

As described in Nusbaum, dynamic web page technology is methods and systems for building server pages on the fly. Clearly dynamic web pages generally and JSPs in particular, that is, "Web pages with dynamic content," are not email. Email, transcoding or not, in fact is not and cannot be implemented as part of dynamic web page technology, that is, for building web pages dynamically, without changing the principals of operation of the dynamic web page technology.

For further explanation, applicants note with respect that dynamic web page technology as described in Nusbaum takes as its inputs HTTP REQUEST and HTTP POST messages bearing query data representing parameters whose varying values affect dynamism among web page structures. Dynamic web page technology as described in Nusbaum produces as its outputs HTTP RESPONSE messages. This dynamic web page functionality as described in Nusbaum includes neither transcoding functionality nor email functionality, and transcoding and email functionality cannot be added to it without

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changing its principals of operation. It is pertinent to note in support of this conclusion that neither the word "transcode" nor the word "email" occurs ever, not even once, anywhere in Nusbaum. It cannot possibly be obvious to one of ordinary skill in the art at the time of the invention, therefore, to combine Nusbaum, Sun1, and Sun2. The proposed combination of Nusbaum, Sun1, and Sun2 therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn, and the case should be allowed.

Nusbaum Teaches Away From the
Claims of the Present Application

Turning now to the substance of Nusbaum, Nusbaum actually teaches away from the current application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Nusbaum discloses dynamic web page technology with no mention of transcoding, gateways, or email. Clearly there would be no impulse on the part of developers of dynamic web page technology to incorporate transcoding gateways or email into dynamic page technology. By effecting dynamic web page technology alone, with no hint or suggestion that transcoding gateways or pertinent email technology might even exist, Nusbaum teaches directly away from the combination with Sun1 and Sun 2 proposed in the Office Action. Nusbaum teaches a kind of dynamic web page technology: "JavaServer Pages (JSP) technology provides developers with an easy and powerful way to build Web pages with dynamic content." Nusbaum, Section 1.4, page 13. Nusbaum does not teach a method of email administration as claimed in the present application. As such, Nusbaum teaches away from applicants' claims. Because Nusbaum teaches away from the applicants' claims, the proposed modification of Nusbaum with Sun1 and Sun2 cannot support a prima facie case of obviousness. The rejection of applicants' claims should be withdrawn and the case should be allowed.

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Nusbaum, Sun1, and Sun2 Do Not Teach
Each and Every Element of the Claim

To establish a prima facie case of obviousness, the proposed combination of Nusbaum, Sun1, and Sun2 must disclose all of applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

The Office Action states that Sun2 at page 55 teaches the claimed elements of "receiving an email message," "the email message having destination mailbox address and object," "email information having mailbox address field," "a mailbox address identical to the destination mailbox address of the email message," "an internet address field," "a file format code field: and "a path name field." In fact, Sun2, which at page 55 merely refers to MIME parts and MIME RFCs, makes no mention whatsoever of the claimed data elements. The fact that Sun2 makes general references to MIME parts in email messages or to MIME RFCs is completely insufficient to anticipate or suggest claim elements in the present application. This ground of rejection should be withdrawn.

Nusbaum Cannot be a Reference Against the Claims of the Present
Application Because Nusbaum Represents Nonanalogous Art

Nusbaum cannot be a reference against the claims of the present application because Nusbaum represents nonanalogous art within the meaning of *In Re Horn*, *Clay*, and *Oetiker*. *In re Horn*, 203 USPQ 969 (CCPA 1979), *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), *In re Oeticker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The field of the inventors' effort in this case is routing email according to its content. The present application claims, among other things, receiving an email message in a transcoding gateway, transcoding into a digital file a digital object included in the email message, and downloading the digital file to a destination client device. The field of Nusbaum is dynamic web pages for the World Wide Web – which clearly has nothing to do with the technical field of the present application. Nusbaum therefore is not within the field of the inventor's endeavor in this case.

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Because Nusbaum is not within the field of the inventor's endeavor in this case, there can be no basis for believing that Nusbaum as a reference would have been considered by one skilled in the particular art working on the relevant problem to which this invention pertains. That is, there would be no reason for an inventor concerned with transcoding gateways for email to search for art regarding dynamic generation of web pages. The two simply have nothing to do with one another. Nusbaum as a reference therefore is not reasonably pertinent to the particular problem with which the inventors were involved in the present case and is not available as a reference against the present application. Applicants respectfully propose that for this reason alone the rejection of the present claims should be withdrawn, and the claims should be allowed.

Conclusion

All claims in the present case stand rejected under 35 U.S.C § 103(a). Independent claims 1, 23, and 45 stand rejected under 35 U.S.C § 103(a) over Nusbaum in view of Sun1 further in view of Sun2. The combination of Nusbaum, Sun1, and Sun2 fails to establish a prima face case of obviousness. The applicants have demonstrated that it is incorrect to reject the independent claims 1, 23, and 45 under 35 U.S.C § 103(a). The applicants respectfully propose that all the dependent claims in the present case stand because the independent claims 1, 23, and 45 stand. The rejection of all the claims 1 - 66 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-66 in light of the present remarks is respectfully requested.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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